Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ILEANA BARNS-SLAVIN,
CLINT F. BRANDIEN, GEORGE J.BRAZIS JR
NORMAN GOODWIN, JACQUES HASBANI,
JOHN B. HOWARD and TERRY E. RAIKES

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Appeal No. 95-4383
Application 08/110,456[1]
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ON BRIEF[2]
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Before MARTIN, BARRETT, and TORCZON, Administrative Patent
Judges.

MARTIN, Administrative Patent Judge.

DECISION ON APPEAL

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[1] Application for patent filed August 23, 1993.

[2] Appellants waived appearance at oral hearing in paper
No. 17.

This is an appeal under 35 U.S.C. § 134 from the

examiner's final rejection of claims 1-12, all of Appellants'

pending claims, under 35 U.S.C. § 103. We reverse.

The invention relates to a carrier management system for

enabling a user to determine the shipping charges for shipping

parcels by a selected carrier and is more particularly relates

to such a system wherein discounted shipping charges can be

determined for groups of parcels to be shipped by a selected

carrier to a single consignee.

Claim 1, the sole independent claim, reads as follows:

1.   A manifest system for generating manifests for
parcels shipped by a carrier, said carrier providing discounts
for shipment of groups of parcels which meet predetermined
requirements and are shipped to a common consignee, said
system comprising:
        a) first means for input of weight for parcel

        b) second means for input of information, said
information including shipment data for selecting a class of
service provided by said carrier, a parcel identification
number, and a plurality of operator input signals;

        c) a first memory for storing rate data;

        d) a second memory for storing said predetermined

requirements;

e) output means for outputting prompts to an

operator; and,

f) data processing means responsive to said weight, said shipment data and a first of said operator input signals to append a suffix to said parcel identification number and to store said weight and at least a portion of said shipment data with said parcel identification number and suffix for a first parcel, and for succeeding parcels to increment said suffix and store said parcel identification number and said incremented suffix, and said weight, and wherein

g) said data processing means is further responsive to a second of said operator signals to determine if a group of parcels consisting of said first parcel and said succeeding parcels conforms to said predetermined requirements and, if so, determining discounted shipping costs for said group in accordance with said stored rates, said stored weights, and said stored portion of said shipping data, and if said group does not conform to said requirements controlling said output means to output a prompt to advise that said group does not qualify for said discount.

The Answer indicates that the rejection is based on the

following three references:

Hollingsworth	4,589,555	May 20, 1986
Barns-Slavin et al. (Barns-Slavin)	5,072,397	Dec. 10, 1991
Mayer et al. (Mayer)	5,287,976	Feb. 22, 1994, (filed Oct. 31, 1990)

Although all three references are mentioned in the discussion

of the rejection, only Barns-Slavin is mentioned in the

statement of the rejection, which reads: "Claims 1-12 are

- 3 -

rejected under 35 U.S.C. § 103 as being unpatentable over

Barns-Slavin ('397)" (final Office action at 2; Answer at 3).

As a result, we, like appellants, will consider only that

reference. See In re Hoch, 428 F.2d 1341, 1342, 166 USPQ 406,

407 (CCPA 1970) (where a reference is relied on to support a

rejection, even in a minor capacity, there is no excuse for

not positively including the reference in the statement of the

rejection).

Barns-Slavin discloses a carrier management system which

permits the user to determine the cost of shipping parcels via

a number of different carriers and classes, including any

applicable discounts (col. 1, lines 7-13).[3] In addition to

determining the mailing or shipping charges for a parcel, the

system may be used "to print a manifest, label, tag etc.

related to the shipping of the parcel" (col. 3, lines 5-9).

As shown in Figure 2, the system includes, inter alia, a

microprocessor 20, keyboard 14, load cell (i.e., weighing

device) 23, display 15, printer(s) 24, RAM 26, removable PROM

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[3] Thus, appellants are correct to say that the examiner
erred in describing Barns-Slavin a disclosing "a postage
metering system" (Answer at 3).

31, program memory 21, and database 22. The user can use the

keyboard to enter and store discount information for any of

the carriers and/or classes (col. 1, lines 64- 68).   The

sequence of steps required to enter discount data into the

system is shown in Figure 5 and described at column 5, line 53

et seq. After the user has entered the appropriate password

(block 500) and selected the discount data entry function from

the menu (block 501A), the system prompts the user to select

the carrier and class to which the discount applies (blocks

501 and 502) and the discount method, i.e., flat or percentage

(block 503).

        The user is next prompted to enter the discount
    type, at block 504, i.e. whether the discount is
    applicable to each transaction, or whether it is
    applicable only to a given group of transactions. If the
    user operates the keys to indicate that the discount is
    application for each transaction, the program exits, at
    block 505, for example to return to the menu for entry of
    further discounts, or other procedures. If the user
    selects the discount to be applicable to a group of
    transactions, the system then prompts the user to select
    the group type, at block 506. This selection enables the
    user (at block 507) to program the discount rate to be
    either applicable to each transaction of the group to be
    selected, or to be applicable to the group total after
    the criteria for the group of parcels has been met.
    [Col. 6, lines 8-22.]

These two group types are represented by the two output lines

from block 507, which are labeled "GROUP TOTAL-PER

TRANSACTION" and "GROUP TOTAL AFTER DISCOUNT CRITERIA MET,"

both of which are shown connected as inputs to block 508,

which is labeled "SELECT DISCOUNT CRITERIA."[4] The reference

goes on to say that "[i]f the user has entered a type, e.g.

"flat" or "percent", a prompt is displayed for entry of the

discount criteria, at block 508" (col. 6, lines 23-25). This

appears to be an error, because the "flat" and "percentage"

choices relate to "SELECT DISCOUNT TYPE" block 504 rather than

to "SELECT GROUP TYPE" block 506, which immediately precedes

block 508. In any event, the reference continues:

> The user now has the choice of entering a selection that
> the discount will be based upon the dollar amount of
> usage of the carrier and/or class by the shipper, the
> number of pieces for which the carrier and/or class has
> been used by the shipper, or the total weight of parcels
> that have been shipped by the carrier and/or class.
> After entry of the desired selection, the user is now
> prompted, at block 210, to enter the time period for
> which the discount is to be applicable. . . . After the
> user enters the desired period, the program exits, for
> example to the menu for further entries.

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[4]   It is not clear why the "GROUP TOTAL-PER TRANSACTION"
output of block 507, which does not appear to be based on
discount criteria, is applied as an input to block 508.

It is of course apparent that other techniques may
be employed for entering discount information. The
responses to the prompts are preferably simple in form,
such as Y(es) or N(o) to questions that have two choices,
or numeric entries based upon items listed in the various
menus, in accordance with conventional practice.
The system of the invention stores data
corresponding to previous transactions with each carrier
and/or class, so that it can determine the cost of the
current shipment on the basis of any discounts that are
applicable. The discounts are of course not applied to
the other carriers/classes, unless they have been so
programmed.
In a further aspect of the invention, the system may
print reports to enable the user to determine how much
use had been made of the various discounts, thereby
enabling the user to take as much advantage of the
discounts as possible. For example, the menu 501a may
enable the selection of a subroutine 512 for printing
such reports. [Col. 6, lines 25-61.]

Although Barns-Slavin states that "the computer comprises

means responsive to operation of the selection keys for

applying discounts stored in the second memory means to any

carrier and/or class to which they are applicable "(col. 1,

line 68 to col. 2, line 3), it does not provide any details

about how this is accomplished.

Barns-Slavin does not mention a discount for sending a

group of parcels to the same consignee or assigning the

parcels in such a group with the same identification number

and different suffixes, as required by claim 1. Although

- 7 -

appellants' specification admits that these features were used

in a the J90M system,[5] which or has been marketed by the

assignees of the application on appeal, the examiner does not

rely on these admissions, instead arguing that it would have

been obvious to modify Barnes-Slavin to use an identification

number with different suffixes to identify parcels in a group

of parcels and that also to send a group of parcels to the

same consignee. We do not agree with the examiner that it

would have been obvious to modify Barns-Slavin this manner

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[5] The specification reads in pertinent part as follows
(at page 2, lines 18-27):

   One such [carrier management] system is the J90M
   system, marketed by the assignee of the present
   application. The J90M includes a microprocessor,
   keyboard and display in a single integrated console, a
   separate scale, and a separate printer. The J90M has the
   capability to weight [sic] parcels; input shipment data
   and determine charges as described above; and prints
   address labels and the like as well as manifest[s] for
   parcels to be shipped by a selected carrier.
   The J90M has a capability for handling "multi-
   packages", that is groups of packages which are to be
   delivered to a single consignee. The user enters a
   parcel identification number and shipment data for the
   first package in the group and the system automatically
   appends a distinct suffix to the parcel identification
   number for each package in the group and uses the
   shipment data input for the first package to compute the
   shipping charges for each package. The J90M however does
   not have a capability for handling group discounts which
   maybe [sic] provided by a carrier.

without relying on appellants' admissions or on other

equivalent prior art. Consequently, we are reversing the §

103 rejection of claims 1-12 for obviousness over Barns-

Slavin.

In view of the clear materiality of the prior art J90M

system to the claimed invention, it is incumbent upon

appellants to provide the examiner with all available relevant

information about that system, including a flow chart

depicting the operation of that system and such operational

details as the prompts, if any, that are used when a

processing a group of parcels for shipment to a single

consignee.

REVERSED

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                                            )
                JOHN C. MARTIN                      )
                Administrative Patent Judge    )
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                                            ) BOARD OF PATENT
                LEE E. BARRETT                      )
                Administrative Patent Judge    )    APPEALS AND
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Appeal No. 95-4383
Application 08/110,456

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